

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**  
JUL 13 2005

**OFFICE OF PETITIONS**

In re application of:

Dwyer *et al.*

Appl. No. 09/190,536

Filed: November 12, 1998

Art Unit: 2645

Examiner: Gerald Gauthier

Atty. Docket: 018632.0091.NPUS00  
(Old Atty Dkt No.02158.0279.NPUS00)

**For: Intelligent Routing of Voice Files  
In A Voice Data Management System**

**Petition Under 37 C.F.R. § 1.313(c) to Withdraw  
U.S. Patent Application Serial No. 09/190,536 from Issue**

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby file this petition requesting that the above-referenced patent application be withdrawn from issue in consideration of a request for continued examination in compliance with 37 C.F.R. § 1.114. Applicants submit the following Statement of Facts in Support of Petition which shows "good and sufficient reasons" why withdrawal of the application from issue is necessary. To summarize, the prosecution history of the application does not reflect that the Examiner considered an Information Disclosure Statement filed on March 29, 1999. In addition, the application prosecution history does not reflect that the Examiner considered three patent applications (now issued patents) listed in a June 26, 2002 Information Disclosure Statement. Finally, there is no indication that two references cited during the prosecution of one of the patent applications listed in the June 26, 2002 Information Disclosure Statement have been considered by the Examiner. Therefore, Applicants are requesting that the above-referenced application be

07/14/2005 AKELLEY 00000007 110404 09190536  
CH01/TABOK/198309.1  
01 FC:1464 130.00 DA

withdrawn from issue and that they be allowed to file a Request For Continued Examination to ensure that the March 29, 1999 Information Disclosure Statement, the three pending applications in the June 26, 2002 Information Disclosure Statement, and the two references are considered by the Examiner. The petition fee (37 C.F.R. §1.17(h)) is believed to be \$130.00. The United States Patent and Trademark Office ("USPTO") is hereby authorized to charge the \$130.00 petition fee, any fee deficiency, or credit any overpayment, to our Deposit Account No. 11-0404 referencing docket number 018632.0091.NPUS00 (Old Atty Dkt No. 02158.0279.NPUS00). *A duplicate copy of this Petition is enclosed.*

In addition, pursuant to 37 C.F.R. § 1.313(c), Applicants also enclose a Request For Continued Examination and an Information Disclosure Statement citing the references that the Applicants would like considered before the above-referenced application is issued. The fee for filing a Request For Continued Examination is believed to be \$790.00. The USPTO is hereby authorized to charge the \$790.00 fee, any fee deficiency, or credit any overpayment, to our Deposit Account No. 11-0404 referencing docket number 018632.0091.NPUS00 (Old Atty Dkt No. 02158.0279.NPUS00). *A duplicate copy of the Request For Continued Examination is enclosed.*

If extensions of time under 37 C.F.R. § 1.136 are required to prevent abandonment of the present patent application, then such extensions of time are hereby petitioned. The USPTO is hereby authorized to charge any fees related to such extensions of time to our Deposit Account

No. 11-0404 referencing docket number 018632.0091.NPUS00 (Old Atty Dkt No. 02158.0279.NPUS00).

**Statement Of Facts In Support Of Petition Under 37 C.F.R. § 1.313(c)  
To Withdraw U.S. Patent Application Serial No. 09/190,536 From Issue**

**I. Background**

1. U.S. Patent Application Serial No. 09/190,536 (“the ‘536 Application”) was filed with the USPTO on November 12, 1998.
2. The ‘536 Application was allowed on April 8, 2005 (See Private PAIR File History Printout, Ex. 1), and the issue fee for the application was paid on June 10, 2005. *Id.*

**II. There Is No Indication In the File History Whether The Examiner Considered A March 26, 1999 Information Disclosure**

3. On March 26, 1999, over two years before the first Office Action issued by the Examiner, the Applicants mailed an Information Disclosure Statement citing four references, U.S. Patent Nos. 5,294,229, 5,398,220, 5,444,768, and 5,548,566, to the USPTO (“the March 1999 IDS”)(Ex. 2).
4. As shown on the attached return postcard, the USPTO received the March 1999 IDS on March 29, 1999 (Ex. 3).
5. During the prosecution of the ‘536 Application, Examiner Gauthier cited U.S. Patent No. 5,398,220 on a Form PTO-892, List of References Cited (Ex. 4), as part of a September 13, 2002 Office Action. Patent Nos. 5,294,229, 5,444,768, and 5,548,566, the remaining three

patents cited in the March 1999 IDS (“the remaining three patents”) were not cited in the Examiner’s List of References Cited.

6. Applicants’ attorneys of record have reviewed their file related to the prosecution of this application and have found no record in their file to indicate that the Examiner considered the remaining three references cited in the March 1999 IDS.

7. Applicants’ attorneys of record also have reviewed the information related to this application on the USPTO’s Private PAIR system to determine whether the three remaining patents cited in the March 1999 IDS were considered by the Examiner.

8. The USPTO’s Private PAIR system does not list the March 1999 IDS in either the File History (Ex. 1) or Image File Wrapper (Ex. 5) sections of Private PAIR.

9. Applicants’ attorneys of record only recently discovered that the application file history does not indicate whether the Examiner considered the references listed on the Form PTO-1449 filed with the March 1999 IDS.

### **III There Is No indication In The File History Whether The Examiner Considered Three Pending Applications Cited In A June 26, 2002 Information Disclosure Statement**

10. In addition, Applicants listed U.S. Patent Application Serial No. 10/000,587 (now U.S. Patent No. 6,493,672), Serial No. 09/190,199, (now U.S. Patent No. 6,571,211), and Serial No. 09/190,196 (now U.S. Patent No. 6,671,567) in an Information Disclosure Statement filed on June 26, 2002 (“the June 2002 IDS”) and stated that these applications contained related technical subject matter (collectively “the related subject matter applications”) (Ex. 6, p. 3).

11. Pursuant to MPEP § 609 (8<sup>th</sup> ed.), Applicants did not list the related subject matter applications on Form PTO-1449 in order to maintain their secrecy (Ex. 7, p. 600-133).
12. On September 13, 2002, Examiner Gauthier issued in an Office Action, which included an initialed copy of Applicants' June 2002 IDS indicating that the Examiner had considered all of the references cited on the Form PTO-1449 on August 23, 2002. The September 13, 2002 Office Action, however, did not contain any indication that the related subject matter applications had been considered by the Examiner (*See* Ex. 4).
13. Applicants' attorneys of record have reviewed their file related to the prosecution of this application and have found no record in their file to indicate that the Examiner considered the related subject matter applications as requested.
14. Applicants' attorneys of record also have reviewed the information related to this application on the USPTO's Private PAIR system to determine whether the related subject matter applications cited in the June 2002 IDS were considered by the Examiner.
15. The USPTO's Private PAIR system does not list any documents in either the File History (Ex. 1) or Image File Wrapper (Ex. 5) sections of Private PAIR, which indicate that Examiner Gauthier reviewed the related subject matter applications.
16. Applicants' attorneys of record only recently discovered that the application file history does not indicate whether the Examiner considered the related subject matter applications listed in the June 2002 IDS.

**IV. There Is No Indication That The Examiner Considered Two References Made Of Record During The Prosecution Of Related Subject Matter Application U.S. Serial No. 10/000,587 (U.S. Patent No. 6,493,672)**

17. Finally, there is no indication whether the Examiner considered two references

(Uploading – A Whatis Definition, Tech Target 2002,

<http://whatis.techtarget.com/definition/0,,sid9-gci213255,00html>, 2 pages and

TechEncyclopedia, Definition of Download, TechWeb: The Business Technology Network,

2002, [www.techweb.com/encyclopedia/defineterm?term=download](http://www.techweb.com/encyclopedia/defineterm?term=download), 2 pages) cited during the

prosecution of related subject matter U.S. Patent Application Serial No. 10/000,587 (now U.S.

Patent No. 6,493,672).

18. Applicants' attorneys of record only recently discovered that Applicants had not separately listed these two references on the Form PTO-1449 filed with the June 2002 IDS.

**V. Applicants Will Be Prejudiced If The Application Is Not Withdrawn From Issue**

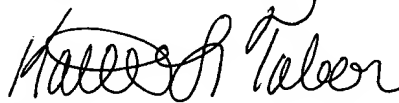
19. The March 26, 1999 and June 26, 2002 Information Disclosure Statements submitted by Applicants complied with the Patent Rules of Practice. As a result, all references cited therein should have been considered by the Examiner. *See* MPEP § 609 (8<sup>th</sup> ed.) (Ex. 7, pp. 600-131-132).

20. Applicants, therefore, respectfully request that this petition be granted and the application withdrawn from issue in consideration for a request for continued examination in compliance with 37 C.F.R. § 1.114.

21. I acknowledge that all statements made herein of my own knowledge are true, and that all statements made herein on information and belief are believed to be true. I understand and accept that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the above-captioned application or any patent issuing thereon.

Dated: July 12, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Katherine L. Tabor", written over a horizontal line.

Katherine L. Tabor (Reg. No. 36,026)  
Attorney For Applicants

KELLEY DRYE & WARREN, LLP  
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**PATENT APPLICATION INFORMATION RETRIEVAL**

Search results as of: 7-11-2005::17:11:51 E.T.

Search results for application number: 09/190,536			
Application Number:	09/190,536	Customer Number:	47669
Filing or 371(c) Date:	11-12-1998	Status:	Publications – Issue Fee Payment Verified
Application Type:	Utility	Status Date:	06-23-2005
Examiner Name:	GAUTHIER, GERALD	Location:	ELECTRONIC
Group Art Unit:	2645	Location Date:	-
Confirmation Number:	6771	Earliest Publication No:	-
Attorney Docket Number:	B653-024	Earliest Publication Date:	-
Class/ Sub-Class:	379/067.1	Patent Number:	-
First Named Inventor:	JOHN J. DWYER, STRATFORD, CT (US)	Issue Date of Patent:	-
Title Of Invention:	INTELLIGENT ROUNTING OF VOICE FILES IN VOICE DATA MANAGEMENT SYSTEM		

## Search Options

Assignments
Continuity Data
Image File Wrapper
Patent Term Extension History
Publication Review

File History	
Date	Contents Description
06-24-2005	Application Is Considered Ready for Issue
06-13-2005	Workflow - Drawings Finished
06-13-2005	Issue Fee Payment Verified
06-13-2005	Issue Fee Payment Received
02-28-2005	Miscellaneous Incoming Letter
04-08-2005	Mail Notice of Allowance
04-05-2005	Issue Revision Completed
04-05-2005	Notice of Allowance Data Verification Completed
04-04-2005	Notice of Allowability
03-14-2005	IFW TSS Processing by Tech Center Complete
03-15-2005	Change in Power of Attorney (May Include Associate POA)
02-28-2005	Miscellaneous Incoming Letter
02-17-2005	Change in Power of Attorney (May Include Associate POA)
02-16-2005	Correspondence Address Change
02-17-2005	Change in Power of Attorney (May Include Associate POA)



02-17-2005	Change in Power of Attorney (May Include Associate POA)
01-25-2005	Date Forwarded to Examiner
12-12-2002	Response after Non-Final Action
05-11-2004	Miscellaneous Incoming Letter
09-13-2002	Mail Non-Final Rejection
09-09-2002	Non-Final Rejection
07-30-2002	Miscellaneous Incoming Letter
06-26-2002	Information Disclosure Statement (IDS) Filed
07-02-2002	Date Forwarded to Examiner
06-26-2002	Response after Non-Final Action
06-23-2002	Correspondence Address Change
04-08-2002	Mail Non-Final Rejection
04-05-2002	Non-Final Rejection
02-07-2002	Date Forwarded to Examiner
01-29-2002	Response after Non-Final Action
01-29-2002	Request for Extension of Time - Granted
10-25-2001	Mail Non-Final Rejection
10-22-2001	Non-Final Rejection
09-08-2001	Case Docketed to Examiner in GAU
10-27-2000	Case Docketed to Examiner in GAU
06-16-1999	Correspondence Address Change
04-14-1999	Case Docketed to Examiner in GAU
03-04-1999	Application Dispatched from OIPE
03-03-1999	Application Is Now Complete
02-26-1999	CRF Disk Has Been Received by Preexam / Group / PCT
12-08-1998	Notice Mailed--Application Incomplete--Filing Date Assigned
11-24-1998	IFW Scan & PACR Auto Security Review
11-16-1998	Initial Exam Team nn

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : John J. Dwyer, et al.  
Serial No. : 09/190,536  
For : INTELLIGENT ROUTING OF VOICE FILES  
IN VOICE DATA MANAGEMENT SYSTEM  
Filed : November 12, 1998  
Examiner : Unassigned  
Art Unit : 2742  
Assistant Commissioner  
for Patents  
Washington, D.C. 20231


S I R:

INFORMATION DISCLOSURE STATEMENT

This Information Disclosure Statement is filed pursuant  
to 37 CFR 1.97 and 1.98.

Enclosed in duplicate is PTO-1449 listing the references  
AA, AB, AC and AD. Photocopies of the references are also  
enclosed.

Respectfully submitted,

  
Nathaniel Levin  
Reg. No. 34,860  
Attorney for Applicant

ROBIN, BLECKER & DALEY  
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New York, New York 10017  
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FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE  
(Rev. 7-80) PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.  
B653-024

SERIAL NO.  
09/190,536

LIST OF ART CITED BY APPLICANT  
(Use several sheets if necessary)

APPLICANT  
John J. Dwyer, et al.

FILING DATE  
November 12, 1998

ART UNIT  
2742

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS	FLG. DATE IF APPROP
	AA 5 2 9 4 2 2 9	03/14/94	Hartzell et al.	434	336	
	AB 5 3 9 8 2 2 0	03/14/95	Barker	369	25	
	AC 5 4 4 4 7 6 8	08/22/95	Lemaire et al.	379	68	
	AD 5 5 4 8 5 6 6	08/20/96	Barker	369	25	
	AE					
	AF					
	AG					
	AH					
	AI					
	AJ					
	AK					

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS	FLG. DATE IF APPROP
	AL						

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION YES NO	
	AS							
	AT							
	AU							
	AV							
	AW							

## OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	AX		
	AY		
	AZ		

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

NL/AN

3/26/99

B653-024

HON. COMMISSIONER OF PATENTS:

We are forwarding herewith PTO-1449 (ny file) IDS

43 references

in the application of

John J. Owyer, et al

Serial No. 09/190,536

for Intelligent Routing of Voice Files in Voice Data

management system

filed 11/12/98; in Group 2742

Kindly have the Mail Room stamp this card and return it to us so that we may know the above has been duly received.

MAR 29 1999

Respectfully,

ROBIN, BLECKER & DALEY

EXPRESS MAIL LABEL NO. \_\_\_\_\_



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/190,536	11/12/1998	JOHN J. DWYER	B653-024	6771

22930 7590 09/13/2002

HOWREY SIMON ARNOLD & WHITE LLP  
BOX 34  
1299 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

02158.0299.NPUS00

EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED  
DOCKET DEPT.  
HOWREY SIMON ARNOLD & WHITE

SEP 17 2002

WASHINGTON, D.C.

DOCKETED  
Sum 9/17/02

# Office Action Summary

Application No.

09/190,536

Applicant(s)

DWYER ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,8-11,18-21,23-27,29 and 35-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-11,18-21, 23-27, 29 and 35-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. **Claims 1, 9, 11, 19, 29, 35, 40, 42, 44-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui et al. (US 5903,871) in view of Suzuki et al. (U.S. 5,986,568).



Art Unit: 2645

Regarding **claims 1, 11 and 29**, Terui discloses a voice recording and reproducing apparatus, comprising:

a voice recording and reproducing apparatus (column 8, lines 61-63) (which reads on claimed "a portable digital audio recorder"), which includes memory means (38 on FIG. 6) for storing a plurality of voice data files (column 11, lines 38-39), the memory means storing an index information area (column 11, lines 33-34) (which reads on claimed "corresponding header data in association with each of the stored data files") (column 10, lines 59-65 and column 11, lines 28-49) [The files are stored with the header information recorded in the index information area];

a personal computer (column 8, line 1).

Terui fails to disclose means for transferring voice data files, another information processing device and means for interconnecting the personal computer with the other processing devices.

However, Suzuki teaches means for transferring one of the voice data files and the corresponding header data from the PDA (column 7, line 51) (which reads on claimed "portable recorder") to a server device (column 7, line 52) (which reads on claimed "the personal computer (column 7, lines 50-54) [The information is transferred by data communication].

an information processing device ( 30 on FIG. 27) other than the portable recorder and the personal computer [The fax is an other information processing device];  
and

means, interconnecting the personal computer with the other information processing device, (3 on FIG. 27) for permitting transmission of data from the personal computer to the other data processing device (column 8, lines 26-36);

wherein the personal computer reads the header data transferred to the personal computer (column 11, lines 6-12), and uses the header data to determine whether to transfer the corresponding voice data file to the other information processing device (column 22, lines 18-25) [The transfer is made according to the destination information in the header files].

Wherein the header data that is used to determine to transfer the corresponding voice data file to the other information processing device is indicative of an identify of the portable digital recorder (column 22, lines 58-65) [The personal allocated ID on the PDA side which the identity of portable digital recorder].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use other information transfer method and system of Suzuki in the invention of Terui.

The modification would offer the capability of transferring files from the portable audio recorder to the personal computer and transferring the information to another processing system based on the header files such as the system would determine the destination of the voice files recorded.

Regarding **claims 9 and 35** Terui and Suzuki discloses all the limitations of the **claim 9** as stated in the **claim 1** rejection.

In addition, Terui teaches a dictation system (column 5, lines 34-36).

Regarding **claim 19**, Terui and Suzuki disclose all the limitations of **claim 19** as stated in **claims 1 and 9** rejection.

Regarding **claim 40**, Terui and Suzuki disclose all the limitations of claim 40 as stated in claim 1 rejection.

In addition, Terui discloses a microphone (1 on FIG.1).

Regarding **claim 42**, Terui and Suzuki as applied to **claim 40** disclose all the limitations of **claim 42**.

Regarding **claim 44**, Terui and Suzuki as applied to **claim 1** rejection disclose the limitation of **claim 44**.

Art Unit: 2645

Regarding **claim 45**, Terui and Suzuki as applied to **claim 1** differ from **claim 45** in that it fails to disclose the header is indicative of a subject matter.

However, Suzuki teaches the header data is indicative of a subject matter (column 12, lines 11-24).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the header is indicative of a subject matter of Suzuki in the invention.

Doing so the system would transmit voice data using the subject matter.

Regarding **claim 46**, Terui and Suzuki as applied to **claim 1** differ from **claim 46** in that it fails to disclose the header is indicative of a work type.

However, Suzuki teaches the header data is indicative of a work type (column 12, lines 11-24).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the header is indicative of a work type of Suzuki in the invention.

Doing so the system would transmit voice data using the type of disease.

3. **Claims 8, 18 and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki and in further view of Salazar et al. (U.S. 5,774,841).

Regarding **claims 8 and 18**, Terui and Suzuki as applied to **claims 1 and 11** above differ from **claims 8 and 18** in that it fails to disclose other information-processing device is another personal computer.

However, Salazar teaches the other information-processing device is another personal computer (40 on FIG. 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the other information-processing device as another personal computer of Salazar in the invention of Terui and Suzuki.

Doing so would send the commands over the communication path.

Regarding **claim 41**, Terui and Suzuki as applied to **claim 40** above differ from **claim 41** in that it fails to disclose information processing device as another personal computer.

However, Salazar teaches the one of the plurality of information processing devices selected by the personal computer is another personal computer (40 on FIG.2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use information processing device as another personal computer of Suzuki in the invention of Terui and Suzuki.

Doing so would transmit voice data to a computer.

Art Unit: 2645

4. **Claims 10, 20-21, 23-25, 27 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki and in further view of Bergeron et al. (US 5,033,077).

Regarding **claims 10, 20 and 36**, Terui and Suzuki as applied to **claims 1, 11 and 29** above differ from **claims 10, 20 and 36** in that it fails to disclose other information processing devices is a voice mail system.

However, Bergeron teaches a voice mail system (column 4, lines 29-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the voice mail of Bergeron in the invention Terui and Suzuki.

The modification would have the capability of transferring the voice data to a voice mail system such as the user would be able to listen to his voice mail message.

Regarding **claim 21**, Terui and Suzuki disclose all the limitations of claim 21 as stated in claim rejection in that it fails to disclose the information process as a voice mail system.

However, Bergeron teaches a voice mail system (column 4, lines 29-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the voice mail of Bergeron in the invention Terui and Suzuki.

The modification would have the capability of transferring the voice data to a voice mail system such as the user would be able to listen to his voice mail message.

Regarding **claim 23**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 23** in that it fails to disclose data, identifying a portable digital audio recorder.

However, Suzuki teaches the header data read by the personal computer includes data, which identifies the portable digital audio recorder ( "CORRESPONDING ITEM ADDRESS" on FIG.8).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a data, which identifies a portable digital audio recorder of Suzuki in the invention.

Doing so would transmit data to describe the item address.

Regarding **claim 24**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 24** in that it fails to disclose data, identifying an intended recipient.

However, Suzuki teaches the header data read by the personal computer includes data, which identifies an intended recipient for the voice data file corresponding to the header data ( "DATA PORTION" on FIG. 8).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a data, which identifies an intended recipient of Suzuki in the invention.

Doing so would transmit data to the appropriate recipient.

Regarding **claim 25**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 25** in that it fails to disclose data, identifying a subject matter.

However, Suzuki teaches the header data read by the personal computer includes data, which identifies a subject matter of the voice data file corresponding to the header data ( "CLASSIFICATION OF DATA" on FIG. 8).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a data, which identifies a subject matter of Suzuki in the invention.

Doing so would transmit data with specifications.

Regarding **claim 27**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 27**.

In addition, Terui discloses the one of the plural of information processing devices selected by the personal computer is a central dictation system (column 5, lines 34-36).



Art Unit: 2645

5. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki in view of Bergeron and in further view of Salazar.

Regarding **claim 26**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 26** in that it fails to disclose information processing device as another personal computer.

However, Salazar teaches the one of the plurality of information processing devices selected by the personal computer is another personal computer (40 on FIG.2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use information processing device as another personal computer of Salazar in the invention of Terui, Suzuki and Bergeron.

Doing so would transmit voice data to a computer.

Art Unit: 2645

6. **Claims 37-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki and in further view of Barker (US 5,398,220).

Regarding **claim 37**, Terui and Suzuki disclose all the limitations of the claim 37 as stated in claim rejection, in that it fails to disclose a speech recognition algorithm.

However, Barker teaches applying a speech recognition algorithm to the recipient information to generate recipient data (column 2, lines 1-7).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a speech recognition algorithm of Barker in the invention of Terui and Suzuki.

The modification would apply a speech recognition algorithm to the recipient information to generate recipient data transmit data to the device such as the system would recognized utterance in the voice files and route the files to destination.

Regarding **claim 38**, Terui, Suzuki and Barker as applied to **claim 37** above differ from **claim 38** in that it fails to disclose transferring the dictated information in the form of digital voice data.

However, Barker teaches the step of transferring the dictated recipient information from the recorder to the personal computer in the form of digital voice data (column 3, lines 17-28).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a digital voice data of Barker in the invention of Terui and Suzuki.

The modification would apply the step of transferring the dictated recipient information from the recorder to the personal computer in the form of digital voice data such as the system would transfer the voice in a digital form.

Regarding **claim 39**, Terui, Suzuki and Barker as applied to **claim 37** disclose all the limitations of **claim 39**.

7. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Bergeron and in further view of Raji et al. (U.S. 5,812,882)

Terui and Suzuki as applied to **claim 40** above differ from **claim 43** in that it fails to disclose a local area network.

However, Raji teaches wherein the means for transmission of data from the personal computer to the data processing devices includes a local area network (column 33, lines 18-20).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a local area network of Raji in the invention of Terui and Suzuki.

Doing so would transmit voice data to the Ethernet.

#### ***Response to Arguments***


8. Applicant's arguments with respect to **claims 1, 8-11, 18-20, 21-27, 29 and 35-46** have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

  
g.g.  
September 2, 2002

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600



**Notice of References Cited**

Application/Control No.

09/190,536

Applicant(s)/Patent Under  
Reexamination  
DWYER ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,398,220	03-1995	Barker, Bruce J.	379/75
	B	US-5,986,568	11-1999	Suzuki et al.	455/517
	C	US-5,812,882	09-1998	Raji et al.	379/75
	D	US-5,033,077	07-1991	Bergeron et al.	379/75
	E	US-5,774,841	06-1998	Salazar et al.	704/225
	F	US-5,903,871	05-1999	Terui et al.	704/270
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

FORM PTO-1449  
INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.: 02158.0279.NPUS00

APPLICATION NO.: 09/190,536

APPLICANT: Dwyer *et al.*

FILING DATE: November 12, 1998

GROUP: 2645

U.S. PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
G.G.	AB1	4,837,830	6/6/89	Wrench, Jr. <i>et al.</i>			
G.G.	AC1	5,033,077	7/16/91	Bergeron <i>et al.</i>			
G.G.	AD1	5,146,439	9/8/92	Jachmann <i>et al.</i>			
G.G.	AE1	5,216,744	6/1/93	Alleyne <i>et al.</i>			
G.G.	AF1	5,265,075	11/23/93	Bergeron <i>et al.</i>			
G.G.	AI1	5,423,034	6/6/95	Cohen-Levy <i>et al.</i>			
G.G.	AK1	5,477,511	12/19/95	Englehardt			

FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
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	AM1						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AN1						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AO1						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AP1						<input type="checkbox"/> Yes <input type="checkbox"/> No

EXAMINER INITIALS	REF. NO.	OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
G.G.	AS 1	Lisa J. Stifelman, "VoiceNotes: An Application for a Voice-Controlled Hand-Held Computer," MIT Master's Thesis (June, 1992).
	AT 1	

EXAMINER

*Gerald Spaulding*

DATE CONSIDERED

8/23/2002

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449  
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## U.S. PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
G.G.	AA2	5,481,645	1/2/96	Bertino <i>et al.</i>			
G.G.	AB2	5,491,774	2/13/96	Norris <i>et al.</i>			
G.G.	AD2	5,568,538	10/22/96	Tamir <i>et al.</i>			
G.G.	AE2	5,729,734	3/17/98	Parker <i>et al.</i>			
G.G.	AF2	5,742,736	4/21/98	Haddock			
G.G.	AG2	5,774,841	6/30/98	Salazar <i>et al.</i>			
G.G.	AH2	5,799,280	8/25/98	Degen <i>et al.</i>			
G.G.	AI2	5,812,882	9/22/98	Raji <i>et al.</i>			
G.G.	AJ2	5,818,800	10/6/98	Barker			
G.G.	AK2	5,839,108	11/17/98	Daberko <i>et al.</i>			

## FOREIGN PATENT DOCUMENTS

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	AN2						<input type="checkbox"/> Yes <input type="checkbox"/> No
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	AP2						<input type="checkbox"/> Yes <input type="checkbox"/> No

EXAMINER INITIALS	REF. NO.	OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
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	AS 2	
	AT 2	

EXAMINER

*Eerald Gault*

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APPLICATION NO.: 09/190,536

APPLICANT: Dwyer *et al.*

FILING DATE: November 12, 1998

GROUP: 2645

## U.S. PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
G.G.	AB3	5,903,871	5/11/99	Terui <i>et al.</i>			
G.G.	AE3	6,038,199	3/14/00	Pawlowski <i>et al.</i>			
G.G.	AG3	6,175,822	1/16/01	Jones			
G.G.	AI3	6,308,158	10/23/01	Kuhnen <i>et al.</i>			
G.G.	AJ3	6,321,129	11/20/01	D'Agosto, III			
G.G.	AK3	6,356,754	3/12/02	Onozawa <i>et al.</i>			

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
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	AM3						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AN3						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AO3						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AP3						<input type="checkbox"/> Yes <input type="checkbox"/> No

EXAMINER INITIALS	REF. NO.	OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
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	AS 3	
	AT 3	

EXAMINER

*Charles J. Anthony*

DATE CONSIDERED

8/23/2002

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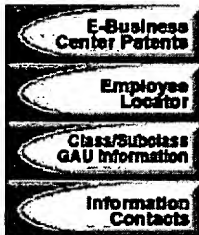
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### Image File Wrapper for Application No.:09/190,536

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06/13/2005	<a href="#">Issue Fee Payment Recorded</a>	PROSECUTION	1	
06/13/2005	<a href="#">Drawings</a>	PROSECUTION	10	
04/08/2005	<a href="#">Search information including classification, databases and other search related notes</a>	PROSECUTION	1	
04/08/2005	<a href="#">Index of Claims</a>	PROSECUTION	1	
04/08/2005	<a href="#">Issue Information including classification, examiner, name, claim, renumbering, etc.</a>	PROSECUTION	1	
04/08/2005	<a href="#">Bibliographic Data Sheet</a>	PROSECUTION	2	
04/08/2005	<a href="#">Notice of Allowance and Fees Due (PTOL-85)</a>	PROSECUTION	3	
04/08/2005	<a href="#">Notice of Allowance and Fees Due (PTOL-85)</a>	PROSECUTION	3	
02/28/2005	<a href="#">Miscellaneous Incoming Letter</a>	PROSECUTION	2	
09/21/2004	<a href="#">Power of Attorney (may include Associate POA)</a>	PROSECUTION	9	
12/12/2002	<a href="#">Applicant Arguments or Remarks Made in an Amendment</a>	PROSECUTION	9	
12/12/2002	<a href="#">Amendment - After Non-Final Rejection</a>	PROSECUTION	1	
12/12/2002	<a href="#">Miscellaneous Incoming Letter</a>	PROSECUTION	1	
09/13/2002	<a href="#">Non-Final Rejection</a>	PROSECUTION	16	
09/13/2002	<a href="#">List of references cited by examiner</a>	PRIOR ART	1	
09/01/2002	<a href="#">Examiner's search strategy and results</a>	PROSECUTION	2	
07/31/2002	<a href="#">Power of Attorney (may include Associate POA)</a>	PROSECUTION	8	
07/30/2002	<a href="#">Power of Attorney (may include Associate POA)</a>	PROSECUTION	9	
06/26/2002	<a href="#">NPL Documents</a>	PRIOR ART	126	
06/26/2002	<a href="#">List of References cited by applicant and considered by examiner</a>	PRIOR ART	3	
06/26/2002	<a href="#">Information Disclosure Statement (IDS) Filed</a>	PROSECUTION	4	
06/26/2002	<a href="#">Applicant Arguments or Remarks Made in an Amendment</a>	PROSECUTION	14	
06/26/2002	<a href="#">Claims</a>	PROSECUTION	2	

06/26/2002	Amendment - After Non-Final Rejection	PROSECUTION	2	
06/24/2002	Applicant Response to Pre-Exam Formalities Notice	PROSECUTION	2	
05/31/2002	Power of Attorney (may include Associate POA)	PROSECUTION	4	
04/08/2002	Non-Final Rejection	PROSECUTION	24	
04/08/2002	List of references cited by examiner	PRIOR ART	1	
02/07/2002	Extension of Time	PROSECUTION	2	
01/29/2002	Miscellaneous Incoming Letter	PROSECUTION	1	
01/29/2002	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION	10	
01/29/2002	Claims	PROSECUTION	5	
01/29/2002	Amendment - After Non-Final Rejection	PROSECUTION	1	
10/25/2001	List of references cited by examiner	PRIOR ART	1	
10/25/2001	Notice of Formal Drawings Required	PROSECUTION	2	
10/25/2001	Non-Final Rejection	PROSECUTION	21	
06/16/1999	Change of Address	PROSECUTION	1	
02/19/1999	Extension of Time	PROSECUTION	1	
02/19/1999	Miscellaneous Incoming Letter	PROSECUTION	2	
02/19/1999	Oath or Declaration filed	PROSECUTION	3	
12/08/1998	Pre-Exam Formalities Notice	PROSECUTION	1	
11/12/1998	Fee Worksheet (PTO-875)	PROSECUTION	1	
11/12/1998	Bibliographic Data Sheet	PROSECUTION	2	
11/12/1998	Abstract	PROSECUTION	1	
11/12/1998	Claims	PROSECUTION	8	
11/12/1998	Specification	PROSECUTION	18	
11/12/1998	Drawings	PROSECUTION	10	
11/12/1998	Transmittal letter	PROSECUTION	1	
11/12/1998	Index of Claims	PROSECUTION	1	
11/12/1998	Search information including classification, databases and other search related notes	PROSECUTION	1	
11/12/1998	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION	1	
11/12/1998	Miscellaneous Incoming Letter	AS FILED	39	

Sorted By : Mail Room Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Dwyer *et al.*

Appl. No. 09/190,536

Filed: November 12, 1998

For: Intelligent Routing of Voice Files in  
Voice Data Management System

Art Unit: 2645

Examiner: Gauthier

Atty. Docket: 02158.0279.NPUS00  
(formerly B653-024)

**Information Disclosure Statement**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted

herewith. It is further understood that the Examiner will consider information that had been cited by or submitted to the U.S. Patent and Trademark Office in a prior application relied on under 35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

Applicants have checked the appropriate boxes below.

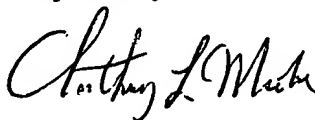
- ☐ 1. This Information Disclosure Statement is being filed within three months of the U.S. filing date OR before the mailing date of a first Office Action on the merits. No statement under 37 C.F.R. § 1.97(e) or fee is required, or
- ☒ 2. This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection or Notice of Allowance, or action that otherwise closes prosecution in the application, and
- ☐ a. I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1), or
- ☐ b. I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2), or
- ☒ c. Attached is our Check No. \_\_\_\_\_ in the amount of \$ 180.00 in payment of the fee under 37 C.F.R. § 1.17(p).
- ☐ 3. This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but on or before payment of the Issue Fee. Attached is our Check No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ in payment of the fee under 37 C.F.R. § 1.17(i), and

- ☐ a. I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1), or
- ☐ b. I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ 4. Relevance of the non-English language document(s) is discussed in the present specification.
- ☐ 5. The document(s) was/were cited in a corresponding foreign application. An English language version of the foreign search report is attached for the Examiner's information.
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below:
- ☒ 7. The Examiner's attention is directed to co-pending U.S. Patent Applications No. 10/000,587, filed October 19, 2001; 09/190,196, filed November 12, 1998; 09/190,199, filed November 12, 1998, which are directed to related technical subject matter. The identification of these U.S. Patent Applications is not to be construed as a waiver of secrecy as to those applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.
- ☐ 8. Copies of the documents were cited by or submitted to the Office in Application No. \_\_\_\_\_, filed \_\_\_\_\_, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and to indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 08-3038 referencing docket number 02158.0279.NPUS00.

Respectfully submitted,



Anthony L. Meola (Reg. No. 44,936)

Michael J. Stimson (Reg. No. 45,429)

Date: June 26, 2002

HOWREY SIMON ARNOLD & WHITE, LLP  
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Washington, D.C. 20004-2402  
(202) 783-0800

FORM PTO-1449  
INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.: 02158.027 PUS00 APPLICATION NO.: 09/190,536

APPLICANT: Dwyer *et al.*

FILING DATE: November 12, 1998

GROUP: 2645

U.S. PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AB1	4,837,830	6/6/89	Wrench, Jr. <i>et al.</i>			
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	AK1	5,477,511	12/19/95	Englehardt			

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	AP1						<input type="checkbox"/> Yes <input type="checkbox"/> No

EXAMINER INITIALS

REF. NO.

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AS

1

Lisa J. Stifelman, "VoiceNotes: An Application for a Voice-Controlled Hand-Held Computer," MIT Master's Thesis (June, 1992).

AT

1

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



FORM PTO-1449  
INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.: 02158.027 PUS00

APPLICATION NO.: 09/190,536

APPLICANT: Dwyer *et al.*

FILING DATE: November 12, 1998

GROUP: 2645

## U.S. PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA2	5,481,645	1/2/96	Bertino <i>et al.</i>			
	AB2	5,491,774	2/13/96	Norris <i>et al.</i>			
	AD2	5,568,538	10/22/96	Tamir <i>et al.</i>			
	AE2	5,729,734	3/17/98	Parker <i>et al.</i>			
	AF2	5,742,736	4/21/98	Haddock			
	AG2	5,774,841	6/30/98	Salazar <i>et al.</i>			
	AH2	5,799,280	8/25/98	Degen <i>et al.</i>			
	AI2	5,812,882	9/22/98	Raji <i>et al.</i>			
	AJ2	5,818,800	10/6/98	Barker			
	AK2	5,839,108	11/17/98	Daberko <i>et al.</i>			

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL2						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AM2						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AN2						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AO2						<input type="checkbox"/> Yes <input type="checkbox"/> No
	AP2						<input type="checkbox"/> Yes <input type="checkbox"/> No

EXAMINER INITIALS	REF. NO.		OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
	AR	2	
	AS	2	
	AT	2	

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO.: 02158.0275 PUS00		APPLICATION NO.: 09/190,536
	APPLICANT: Dwyer <i>et al.</i>		
	FILING DATE: November 12, 1998		GROUP: 2645

## U.S. PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AB3	5,903,871	5/11/99	Terui <i>et al.</i>			
	AE3	6,038,199	3/14/00	Pawlowski <i>et al.</i>			
	AG3	6,175,822	1/16/01	Jones			
	AI3	6,308,158	10/23/01	Kuhnen <i>et al.</i>			
	AJ3	6,321,129	11/20/01	D'Agosto, III			
	AK3	6,356,754	3/12/02	Onozawa <i>et al.</i>			

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION	
	AL3						<input type="checkbox"/> Yes	<input type="checkbox"/> No
	AM3						<input type="checkbox"/> Yes	<input type="checkbox"/> No
	AN3						<input type="checkbox"/> Yes	<input type="checkbox"/> No
	AO3						<input type="checkbox"/> Yes	<input type="checkbox"/> No
	AP3						<input type="checkbox"/> Yes	<input type="checkbox"/> No

EXAMINER INITIALS	REF. NO.		OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
	AR	3	
	AS	3	
	AT	3	

EXAMINER	DATE CONSIDERED
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**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

or as part of the specification in paper (in compliance with 37 CFR 1.52).

A single table contained on 51 pages or more may be submitted on a CD-ROM or CD-R (in compliance with 37 CFR 1.52(e) and 37 CFR 1.58). The presentation of a subheading to divide a large table into smaller sections of less than 51 pages should not be used to prevent an applicant from submitting the table on a compact disc unless the subdivided tables are presented as numerous files on the compact disc so as to lose their relationship to the overall large table.

Form paragraphs 6.63.01 and 6.63.02 may be used to notify applicant of corrections needed to comply with the requirements of 37 CFR 1.52(e) and 37 CFR 1.58(b) with respect to tables.

**¶ 6.63.01 CD-ROM/CD-R Requirements (Table Listing in Specification)**

The description portion of this application contains a table consisting of less than fifty one (51) pages only on a CD-ROM or CD-R. In accordance with 37 CFR 1.52(e), only a table of at least fifty one (51) pages may be submitted on a CD-ROM or CD-R. Accordingly, applicant is required to cancel the references to the CD-ROM/CD-R table appearing in the specification on pages[1], file a paper version of the table in compliance with 37 CFR 1.52 and change all appropriate references to the former CD-ROM/CD-R table to the newly added paper version of the table in the remainder of the specification

**Examiner Note:**

1. This form paragraph must be used whenever an application filed on or after November 7, 2000 contains a table on a CD-ROM or CD-R consisting of less than fifty one (51) pages as part of the descriptive portion of the specification.
2. In bracket 1, insert the range of page numbers of the specification which reference the table.

**¶ 6.63.02 Table on CD-ROM/CD-R Column/Row Relationship Not Maintained**

This application contains a table on CD-ROM/CD-R. Tables presented on CD-ROM/CD-R in compliance with 37 CFR 1.58 must maintain the spacial orientation of the cell entries. The table submitted does not maintain the data within each table cell in its proper row/column alignment. The data is misaligned in the table as follows: [1]. Applicant is required to submit a replacement compact disc with the table data properly aligned.

**Examiner Note:**

1. This form paragraph must be used whenever the data in a table cannot be accurately read because the data in the table cells do not maintain their row and column alignments.
2. In bracket 1, insert the area of the table that does not maintain the row and column alignments.

## 608.05(c) Compact Disc Submissions of Biosequences

Filing of biosequence information on compact disc is now permitted in lieu of filing on paper. See MPEP § 2420 and § 2422.03.

## 609 Information Disclosure Statement

### 37 CFR 1.97. Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(3) Before the mailing of a first Office action on the merits; or

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) The statement specified in paragraph (e) of this section; or

(2) The fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) The statement specified in paragraph (e) of this section; and

(2) The fee set forth in § 1.17(p).

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making

reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a *bona fide* attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).

(i) If an information disclosure statement does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office.

### 37 CFR 1.98. Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;

(2) A legible copy of:

(i) Each U.S. patent application publication and U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed;

(iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed; and

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or

published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

Information Disclosure Statements (IDSs) are not permitted in provisional applications filed under 35 U.S.C. 111(b). See 37 CFR 1.51(d). Since no substantive examination is given in provisional applications, a disclosure of information is unnecessary. Any such statement filed in a provisional application will be returned or destroyed at the option of the Office.

In applications filed under 35 U.S.C. 111(a), applicants and other individuals substantively involved with the preparation and/or prosecution of the application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. The provisions of 37 CFR 1.97 and 37 CFR 1.98 provide a mechanism by which patent applicants may comply with the duty of disclosure provided in 37 CFR 1.56. Applicants and other individuals substantively involved with the preparation and/or prosecution of the patent application also may want the Office to consider information for a variety of other reasons; e.g., to make sure that the examiner has an opportunity to consider the same information that was considered by these individuals, or by another patent office in a counterpart or related patent application filed in another country.

An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner assigned to the application. The requirements for the content of a

statement have been simplified in the rules, to encourage individuals associated in a substantive way with the filing and prosecution of a patent application to submit information to the Office so the examiner can evaluate its relevance to the claimed invention. The procedures for submitting an information disclosure statement under the rules are designed to encourage individuals to submit information to the Office promptly and in a uniform manner. These rules provide certainty for the public by defining the requirements for submitting information disclosure statements to the Office so that the Office will consider information contained therein before a patent is granted.

The filing of an information disclosure statement shall not be construed as a representation that a search has been made. 37 CFR 1.97(g). There is no requirement that an applicant for a patent make a patentability search. Further, the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b). 37 CFR 1.97(h). See MPEP § 2129 regarding admissions by applicant.

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement must be (1) in compliance with the content requirements of 37 CFR 1.98, and (2) filed in accordance with the procedural requirements of 37 CFR 1.97. The requirements as to content are discussed in subsection III.A below. The requirements based on the time of filing the statement are discussed in subsection III.B below. Examiner handling of information disclosure statements is discussed in subsection III.C below.

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. Only where the relevancy of the information is

actually discussed in the application file (either by the examiner or by the applicant) or where the information is relied upon to reject a claim in the application, will the information deemed to have been "considered" (to the extent discussed) for the purposes of reexamination under the *Portola* guidelines. See MPEP § 2242 under the subsection "General Principles Governing Compliance With Portola Packaging. Information submitted to the Office that does not comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will not be considered by the Office but will be placed in the application file.

Multiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements of 37 CFR 1.97 and 37 CFR 1.98. Use of form PTO-1449, "Information Disclosure Citation," or PTO/SB/08A and 08B, "Information Disclosure Statement," is encouraged as a means to provide the required list of information as set forth in 37 CFR 1.98(a)(1). Applicants are encouraged to use the USPTO forms when preparing an information disclosure statement. A copy of forms PTO-1449, "Information Disclosure Citation" and PTO/SB/08A and 08B are reproduced at the end of this section to indicate how the forms should be completed. The forms will enable applicants to comply with the requirement to list each item of information being submitted and to provide the Office with a uniform listing of citations and with a ready way to indicate that the information has been considered.

## **I. IDS IN CONTINUED EXAMINATIONS OR CONTINUING APPLICATIONS**

### **A. *IDS That Has Been Considered (1) In The Parent Application, Or (2) Prior To The Filing Of A Request For Continued Examination (RCE)***

#### **1. Continued Prosecution Applications (CPAs) Filed Under 37 CFR 1.53(d) Or File Wrapper Continuing (FWC) Applications Filed Under Former 37 CFR 1.62**

Information which has been considered by the Office in the parent application of a continued prosecution application (CPA) filed under 37 CFR 1.53(d), or a file wrapper continuing application (FWC) filed prior to December 1, 1997 under former 37 CFR 1.62,

will be part of the file before the examiner and need not be resubmitted in the continuing application to have the information considered and listed on the patent.

**2. Continuation Applications or Divisional Applications, Filed Under 37 CFR 1.53(b) Or Filed Under Former 37 CFR 1.60, Or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)**

The examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, (B) a divisional application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, or (C) a continuation-in-part application filed under 37 CFR 1.53(b). Such information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

**3. Requests For Continued Examination (RCE) Under 37 CFR 1.114**

Information which has been considered by the Office in the application before the filing of a RCE will be part of the file before the examiner and need not be resubmitted to have the information considered by the examiner and listed on the patent.

**B. IDS That Has Not Been Considered (1) In The Parent Application, Or (2) Prior To The Filing Of A Request For Continued Examination**

**1. Continued Prosecution Applications Filed Under 37 CFR 1.53(d)**

Information filed in the parent application that complies with the content requirements of 37 CFR 1.98 will be considered by the examiner in the CPA. No specific request from the applicant that the previously submitted information be considered by the examiner is required.

**2. File Wrapper Continuing Application Filed Under Former 37 CFR 1.62**

For FWC applications filed prior to December 1, 1997 under former 37 CFR 1.62, in order to ensure consideration of information complying with the content requirements of 37 CFR 1.98 previously submit-

ted, but not considered, in a parent application, applicant must either specifically request that the previously submitted information be considered in the FWC or resubmit the information in the FWC in compliance with 37 CFR 1.97 and 37 CFR 1.98.

**3. Continuation Applications or Divisional Applications, Filed Under 37 CFR 1.53(b) Or Filed Under Former 37 CFR 1.60, Or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)**

For these types of applications, in order to ensure consideration of information previously submitted, but not considered, in a parent application, applicant must resubmit the information in the continuing application in compliance with 37 CFR 1.97 and 37 CFR 1.98.

**4. Requests For Continued Examination Under 37 CFR 1.114**

Information filed in the application in compliance with the content requirements of 37 CFR 1.98 before the filing of a RCE will be considered by the examiner after the filing of the RCE. For example, an applicant filed an IDS in compliance with 37 CFR 1.98 after the mailing of a final Office action, but the IDS did not comply with the requirements of 37 CFR 1.97(d)(1) and (d)(2) and therefore, the IDS was not considered by the examiner. After applicant files a RCE, the examiner will consider the IDS filed prior to the filing of the RCE. For more details on RCE, see MPEP § 706.07(h).

**II. NATIONAL STAGE APPLICATIONS**

The examiner will consider the documents cited in the international search report in a PCT national stage application when the Form PCT/DO/EO/903 indicates that both the international search report and the copies of the documents are present in the national stage file. In such a case, the examiner should consider the documents from the international search report and indicate by a statement in the first Office action that the information has been considered. There is no requirement that the examiner list the documents on a PTO-892 form.

In a national stage application, the following form paragraphs may be used where appropriate to notify

applicant regarding references listed in the search report of the international application:

**¶ 6.53 References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Prior to Allowance**

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 or PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

**Examiner Note:**

1. This form paragraph may be used for PCT National Stage applications submitted under 35 U.S.C. 371 where the examiner has obtained copies of the cited references. For applications filed from US, JPO or EPO search authorities, the copies of the references should be supplied by those offices under the trilateral agreement. However, if receipt of such copies is not indicated on the PCT/DO/EO/903 form in the file, burden is on the applicant to supply copies for consideration. See MPEP § 1893.03(g).
2. Instead of using this form paragraph, the examiner may list the references on a PTO-892, thereby notifying the applicant that the references have been considered and will be printed on any patent resulting from this application.
3. This form paragraph should only be used prior to allowance when a statutory period for reply is being set in the Office action.
4. If the application is being allowed, form paragraph 6.54 should be used with the Notice of Allowability instead of this form paragraph.

**¶ 6.54 References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Ready for Allowance**

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 or PTO/SB/08A and 08B form, must be filed within ONE MONTH of the mailing date of this communication. NO EXTENSION OF TIME WILL BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b) to comply with this requirement.

**Examiner Note:**

1. See the Examiner Note for form paragraph 6.53.

**¶ 6.55 References Not Considered in 37 U.S.C. 371 Application Based Upon Search Report**

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each U.S. and foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any

drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609 A(1) states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement requirements of 37 CFR 1.97(e). See MPEP § 609 subsection III C(1).

**Examiner Note:**

1. This form paragraph may be used in National Stage applications submitted under 35 U.S.C. 371 where the international searching authority was not the US, EPO or JPO.

**III. MINIMUM REQUIREMENTS FOR AN INFORMATION DISCLOSURE STATEMENT**

**A. Content**

An information disclosure statement must comply with the provisions of 37 CFR 1.98 as to content for the information listed in the IDS to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of subsection III.A(1), A(2), and A(3) below.

**A (1) List of All Patents, Publications, U.S. Applications, or Other Information**

Each information disclosure statement must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office.

37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by

the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

The list of information complying with the identification requirements of 37 CFR 1.98(b) may not be incorporated into the specification of the application in which it is being supplied, but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list (generated by the Office) will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of either form PTO-1449, Information Disclosure Citation, or PTO/SB/08A and 08B, Information Disclosure Statement, to list the documents is encouraged. See subsection C(2) below.

#### **A (2) Legible Copies**

In addition to the list of information, each information disclosure statement must also include a legible copy of:

(A) Each U.S. patent application publication, and U.S. and foreign patent;

(B) Each publication or that portion which caused it to be listed;

(C) For each cited pending U.S. application, the application specification including the claims, and any drawings of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(D) All other information or that portion which caused it to be listed.

37 CFR 1.98(a)(2)(iii) requires a copy of a pending U.S. application that is being cited in an IDS. If the pending U.S. application is only identified in the specification's background information rather than being part of an IDS submission, a copy need not be supplied. Pursuant to 37 CFR 1.98(a)(2)(iii), applicant may choose to cite only a portion of a pending application including any claims directed to that portion rather than the entire application.

There are exceptions to this requirement that a copy of the information must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication, pending U.S. application, or other information listed in an information disclosure statement is not required to be provided if: (1) the information was previously cited by or submitted to, the Office in a prior application, provided that the prior application is properly identified in the IDS and is relied on for an earlier filing date under 35 U.S.C. 120; and (2) the IDS submitted in the earlier application complies with 37 CFR 1.98(a)-(c). If both of these conditions are met, the examiner will consider the information previously cited or submitted to the Office and considered by the Office in a prior application relied on under 35 U.S.C. 120. This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See subsection III.A(3) below.



Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO-1449, or PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted)).

37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

### **A (3) Concise Explanation of Relevance for Non-English Language Information**

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in

37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted in the IDS.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. However, see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) (“[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.”).

In *Semiconductor Energy Laboratory*, patentee during prosecution submitted an untranslated 29-page Japanese reference as well as a concise explanation of its relevance and an existing one-page partial English translation, both of which were directed to less material portions of the reference. The untranslated portions of the Japanese reference “contained a more complete combination of the elements claimed [in the patent] than anything else before the PTO.” 204 F.3d at 1376, 54 USPQ2d at 1005. The patentee, whose native language was Japanese, was held to have understood the materiality of the reference. “The duty of candor does not require that the applicant translate every foreign reference, but only that the applicant refrain from submitting partial translations and concise explanations that it knows will misdirect the examiner’s attention from the reference’s relevant teaching.” 204 F.3d at 1378, 54 USPQ2d at 1008.

Although a concise explanation of the relevance of the information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or

where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

## B. Time for Filing

The procedures and requirements under 37 CFR 1.97 for submitting an information disclosure statement are linked to four stages in the processing of a patent application:

(1)(a) for national applications (not including CPAs), within 3 months of filing, or before the mailing of a first Office action on the merits, whichever is later;

(b) for international applications, within 3 months of the date of entry of the national stage as set forth in 37 CFR 1.491 or before the mailing of a first Office action on the merits in the national stage application, whichever is later;

(c) for continued examinations (i.e., RCEs filed under 37 CFR 1.114) and CPAs filed under 37 CFR 1.53(d), before the mailing of a first Office action on the merits;

(2) after the period in (1), but prior to the prosecution of the application closes, i.e., before the mailing of a final Office action, a Notice of Allowance, or an *Ex parte Quayle* action, whichever is earlier;

(3) after the period in (2) but on or before the date the issue fee is paid; and

(4) after the period in (3) and up to the time the patent application can be effectively withdrawn from issue under 37 CFR 1.313(c).

These procedures and requirements apply to applications filed under 35 U.S.C. 111(a) (utility), 161 (plants), 171 (designs), and 251 (reissue), as well as international applications entering the national stage under 35 U.S.C. 371.

The requirements based on the time when the information disclosure statement is filed are summarized as follows.

<u>Time when IDS is filed</u>	<u>37 CFR 1.97 Requirements</u>
(1)(a) for national applications (not including CPAs), within 3 months of filing or before first Office action on the merits, whichever is later; (b) for national stage applications, within 3 months of entry into national stage or before first Office action on the merits, whichever is later; (c) for RCEs and CPAs before the first Office action on the merits.	None (IDS will be considered).
(2) After (1) but before final action, notice of allowance, or <i>Quayle</i> action.	1.97(e) statement or 1.17(p) fee.
(3) After (2) and before (or with) payment of issue fee.	1.97(e) statement, and 1.17(p) fee.
(4) After payment of issue fee.	IDS will not be considered. (See petition under 37 CFR 1.313(c) to withdraw from issue.)

**B (1) Information Disclosure Statement Filed BEFORE First Action on the Merits or Within Three (3) Months of Actual Filing Date (37 CFR 1.97(b))**

An information disclosure statement will be considered by the examiner if filed within any one of the following time periods:

(A) for national applications (not including CPAs), within 3 months of the filing date of the national application or before the mailing date of a first Office action on the merits;

(B) for international applications, within 3 months of the date of entry of the national stage as set forth in 37 CFR 1.491 or before the mailing date of a first Office action on the merits; or

(C) for RCEs and CPAs, before the mailing date of a first Office action on the merits.

An information disclosure statement filed within one of these periods requires neither a fee nor a statement under 37 CFR 1.97(e). An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or if it is in compliance with the provisions of "Express Mail" delivery under 37 CFR 1.10. An Office action is mailed on the date indicated in the Office action.

It would not be proper to make final a first Office action in a continuing application or in an application after the filing of a RCE if the information submitted in the IDS during the time period set forth in 37 CFR 1.97(b) is used in a new ground of rejection.

**(a) National or International Applications**

The term "national application" includes continuing applications (continuations, divisions, and continuations-in-part but not CPAs), so 3 months will be measured from the actual filing date of an application as opposed to the effective filing date of a continuing application. For international applications, the 3 months will be measured from the date of entry of the national stage.

All information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within 3 months of the filing date, will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. Thus, in the rare instance that a final Office action, a notice of allowance, or an *Ex parte Quayle* action is mailed prior to a date which is 3 months from the filing date, any information contained in a complete information disclosure statement filed within that 3-month window will be considered by the examiner.

Likewise, an information disclosure statement will be considered if it is filed later than 3 months after the application filing date but before the mailing date of a first Office action on the merits. An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement (37 CFR 1.142) or just a requirement for additional fees to have a claim considered (37 CFR 1.16(d)). Thus, if an application was filed on January 2 and the first Office action on the merits was not mailed until 6 months later on July 2, the examiner would be required to consider any proper information disclosure statement filed prior to July 2.

#### (b) RCE and CPA

The 3-month window as discussed above does not apply to a RCE filed under 37 CFR 1.114 or a CPA filed under 37 CFR 1.53(d). An IDS filed after the filing of a RCE will be considered if the IDS is filed before the mailing date of a first Office action on the merits. A RCE is not the filing of an application, but merely the continuation of prosecution in the current application. After the mailing of a RCE, such application is treated as an amended application by the examiner and is subject to a short turnover time. Therefore, applicants are encouraged to file any IDS with the filing of a RCE. See MPEP § 706.07(h) for details on RCEs.

Similarly, an IDS filed in a CPA will be considered if the IDS is filed before the mailing date of a first Office action on the merits. Applicants are encouraged to file any IDS in a CPA as early as possible, preferably at the time of filing of the CPA request.

If an IDS cannot be filed before the mailing of a first Office action on the merits (generally within 2 months from the filing of the RCE or CPA), applicants may request a 3-month suspension of action under 37 CFR 1.103(c) in an application at the time of filing of the RCE, or under 37 CFR 1.103(b) in a CPA, at the time of filing of the CPA. Where an IDS is mailed to the Office shortly before the expiration of a 3-month suspension under 37 CFR 1.103(b) or (c),

applicant is requested to make a courtesy call to notify the examiner as to the IDS submission.

#### **B (2) Information Disclosure Filed After B(1) but BEFORE Mailing of Final Action, Notice of Allowance, or an Ex parte Quayle Action (37 CFR 1.97(c))**

An information disclosure statement will be considered by the examiner if filed after the period specified in subsection III.B(1) above, but prior to the date the prosecution of the application closes, i.e., before (not on the same day as the mailing date of any of the following:

- a final action under 37 CFR 1.113, e.g., final rejection;

- a notice of allowance under 37 CFR 1.311; or

- an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action,

whichever occurs first, provided the information disclosure statement is accompanied by either (1) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection III.B(5) below); or (2) the fee set forth in 37 CFR 1.17(p). If a final action, notice of allowance, or an *Ex parte Quayle* action is mailed in an application and later withdrawn, the application will be considered as not having had a final action, notice of allowance, or an *Ex parte Quayle* action mailed for purposes of considering an information disclosure statement.

An *Ex parte Quayle* action is an action that closes the prosecution in the application as referred to in 37 CFR 1.97(c). Therefore, an information disclosure statement filed after an *Ex parte Quayle* action, must comply with the provisions of 37 CFR 1.97(d).

#### (a) Information is Used in a New Ground of Rejection

##### i) Final Rejection is Not Appropriate

If information submitted during the period set forth in 37 CFR 1.97(c) with a statement under 37 CFR 1.97(e) is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office.

## ii) Final Rejection is Appropriate

The information submitted with a statement under 37 CFR 1.97(e) can be used in a new ground of rejection and the next Office action can be made final, if the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee as set forth in 37 CFR 1.17(p), the examiner may use the information submitted, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 706.07(a).

### **B(3) Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97(d)**

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of any of the following: a final action under 37 CFR 1.113; a notice of allowance under 37 CFR 1.311; or an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

- (A) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection B(5); and
- (B) the fee set forth in 37 CFR 1.17(p).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. Payment of the fee (37 CFR 1.17(p)) and submission of the appropriate statement (37 CFR 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied.

Form paragraph 6.52 may be used to inform the applicant that the information disclosure statement is being considered.

#### **¶ 6.52 Information Disclosure Statement Filed After Prosecution Has Been Closed**

The information disclosure statement (IDS) submitted on [1] was filed after the mailing date of the [2] on [3]. The submission is in compliance with the provisions of 37 CFR 1.97. Accord-

ingly, the information disclosure statement is being considered by the examiner.

#### **Examiner Note:**

1. In bracket 1, insert the date the IDS was filed.
2. In bracket 2, insert --final Office action--, --Notice of Allowance--, or an --*Ex parte Quayle* action-- as appropriate.

The requirements of 37 CFR 1.97 provide for consideration by the Office of information which is submitted within a reasonable time, i.e., within 3 months after an individual designated in 37 CFR 1.56(c) becomes aware of the information or within 3 months of the information being cited in a communication from a foreign patent office in a counterpart foreign application. This undertaking by the Office to consider information would be available throughout the pendency of the application until the point where the patent issue fee was paid.

If an applicant chose not to comply, or could not comply, with the requirements of 37 CFR 1.97(d), the applicant may file a RCE under 37 CFR 1.114, or a continuing application under 37 CFR 1.53(b) or (d) to have the information considered by the examiner. If the applicant files a continuing application under 37 CFR 1.53(b), the parent application could be permitted to become abandoned by not paying the issue fee required in the Notice of Allowance. If the prior application is a design application, or a utility or plant application filed before May 29, 2000, the filing of a continued prosecution application under 37 CFR 1.53(d) automatically abandons the prior application. See the discussion in subsection I. above under the heading "IDS IN CONTINUED EXAMINATIONS AND CONTINUING APPLICATION."

### **B(4) Information Disclosure Statement Filed After Payment of Issue Fee**

After the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information. Information disclosure statements filed after payment of the issue fee in an application will not be considered but will merely be placed in the application file. See subsection C below. The application may be withdrawn from issue at this point, pursuant to 37 CFR 1.313(c)(2) or 1.313(c)(3) so that the information can be considered in the application upon the filing of a RCE under 37 CFR 1.114 or in a continuing application filed under 37 CFR 1.53(b) or 1.53(d). In this situation, a RCE, or a CPA

(if the prior application is a design application, or a utility or plant application filed before May 29, 2000), or a continuing application filed under 37 CFR 1.53(b) could be filed even though the issue fee had already been paid. See MPEP § 1308. Applicants are encouraged to file the petition under 37 CFR 1.313(c)(2) with a RCE, or the petition under 37 CFR 1.313(c)(3) with a CPA or continuing application under 37 CFR 1.53(b), by facsimile transmission to the Office of Petitions (see MPEP § 1730 for the facsimile number). The Office cannot ensure that any petition under 37 CFR 1.313(c) will be acted upon prior to the date of patent grant. Applicants considering filing a petition under 37 CFR 1.313(c) are encouraged to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider and grant a petition under 37 CFR 1.313(c). The petition need not be accompanied by the information disclosure statement if the size of the statement makes its submission by facsimile impracticable, but the petition should indicate that an IDS will be filed in the application or in the continuing application if it does not accompany the petition under 37 CFR 1.313(c). The IDS should be filed before the mailing of a first Office action on the merits. If the IDS cannot be filed within this time period, applicants may request a three-month suspension of action under 37 CFR 1.103 at the time of filing of the RCE or CPA. See the discussion above in paragraph III.B(1)(b) above.

Alternatively, for example, a petition pursuant to 37 CFR 1.313(c)(1) could be filed if applicant states that one or more claims are unpatentable. This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under 37 CFR 1.313(c)(1). Form paragraph 13.09 may be used.

#### ¶ 13.09 Information Disclosure Statement, Issue Fee Paid

Applicant's information disclosure statement of [1] was filed after the issue fee was paid. Information disclosure statements filed after payment of the issue fee will not be considered, but will be placed in the file. However, the application may be withdrawn from issue in order to file a request for continued examination (RCE) under 37 CFR 1.114 upon the grant of a petition under 37 CFR 1.313(c)(2), or a continuing application under 37 CFR 1.53(b) (or a continued prosecution application (CPA) under 37 CFR 1.53(d) if the prior application is a design application, or a

utility or plant application filed before May 29, 2000) upon the grant of a petition filed under the provisions of 37 CFR 1.313(c)(3). Alternatively, the other provisions of 37 CFR 1.313 may apply, e.g., a petition to withdraw the application from issue under the provisions of 37 CFR 1.313(c)(1) may be filed together with an unequivocal statement by the applicant that one or more claims are unpatentable over the information contained in the statement. The information disclosure statement would then be considered upon withdrawal of the application from issue under 37 CFR 1.313(c)(1).

#### Examiner Note:

1. For information disclosure statements submitted after the issue fee has been paid, use this form paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the filing date of the IDS.

If an application has been withdrawn from issue under one of the provisions of 37 CFR 1.313(c)(1)-(3), it will be treated as though no notice of allowance had been mailed and the issue fee had not yet been paid with regard to the time for filing information disclosure statements. Petitions under 37 CFR 1.313(c) should be directed to the Office of Petitions in the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP § 1308.

#### **B(5) Statement Under 37 CFR 1.97(e)**

A statement under 37 CFR 1.97(e) must state either

(1) that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement.

A statement under 37 CFR 1.97(e) can contain either of two statements. One statement is that each item of information in an information disclosure statement was first cited in any communication, such as a search report, from a patent office outside the U.S. in a counterpart foreign application not more than 3 months prior to the filing date of the statement.

Applicant would not be able to make a statement under 37 CFR 1.97(e) where an item of information was first cited by a foreign patent office, for example, a year before the filing of the IDS, in a communication from that foreign patent office, and the same item of information is once again cited by another foreign patent office within three months prior to the filing of the IDS in the Office. Similarly, applicant would not be able to make a statement under 37 CFR 1.97(e) where an item of information was cited in an examination report and the same item of information was previously cited more than three months prior to the filing of the IDS in the Office, in a search report from the same foreign patent office. Under this statement, it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report.

The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 CFR 1.10.

The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application).

Communications from foreign patent offices in foreign applications sometimes include a list of the family of patents corresponding to a particular patent being cited in the communication. The family of patents may include a United States patent or other patent in the English language. Some applicants submit

information disclosure statements to the PTO which list and include copies of both the particular patent cited in the foreign patent office communication and the related United States or other English language patent from the family list. Since this is to be encouraged, the United States or other English language patent will be construed as being cited by the foreign patent office for purposes of a statement under 37 CFR 1.97(e)(1). The examiner should consider the United States or other English language patent if 37 CFR 1.97 and 37 CFR 1.98 are complied with.

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement.

The phrase "after making reasonable inquiry" makes it clear that the individual making the statement has a duty to make reasonable inquiry regarding the facts that are being stated. The statement can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than 3 months, however, cannot make the statement under 37 CFR 1.97(e)(2) without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a statement under 37 CFR 1.97(e)(2) to the Office until a satisfactory response is received. The statement can

be based on present, good faith knowledge about when information became known without a search of files being made.

A statement under 37 CFR 1.97(e) need not be in the form of an oath or a declaration under 37 CFR 1.68. A statement under 37 CFR 1.97(e) by a registered practitioner or any other individual that the statement was filed within the 3-month period of either first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary. For example, a statement under 37 CFR 1.97(e) could read as follows:

I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than 3 months prior to the filing of this statement.,

or

I hereby state that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 CFR 1.56(c) more than 3 months prior to the filing of this Information Disclosure Statement.

An information disclosure statement may include two lists and two statements, similar to the above examples, in situations where some of the information listed was cited in a communication from a foreign patent office not more than 3 months prior to filing the statement and some was not, but was not known more than 3 months prior to filing the statement.

A copy of the foreign search report need not be submitted with the statement under 37 CFR 1.97(e), but an individual may wish to submit an English-language version of the search report to satisfy the requirement for a concise explanation where non-English language information is cited. The time at which information was known to any individual designated in 37 CFR 1.56(c) is the time when the information was discovered in association with the application even if awareness of the materiality came later. The Office wishes to encourage prompt evaluation of the relevance of information and to have a date

certain for determining if a statement under 37 CFR 1.97(e) can properly be made. A statement on information and belief would not be sufficient. Examiners should not remind or otherwise make any comment about an individual's duty of candor and good faith. Questions about the adequacy of any statement received in writing by the Office should be directed to the Office of Patent Legal Administration.

#### **B(6) Extensions of Time (37 CFR 1.97(f))**

No extensions of time for filing an information disclosure statement are permitted under 37 CFR 1.136(a) or (b). If a bona fide attempt is made to comply with the content requirements of 37 CFR 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

#### ***C. Examiner Handling of Information Disclosure Statements***

Information disclosure statements will be reviewed for compliance with the requirements of 37 CFR 1.97 and 37 CFR 1.98 as discussed in subsection III.A and B above. Applicant will be notified of compliance and noncompliance with the rules as discussed below.

#### **C(1) Noncomplying Information Disclosure Statements**

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 37 CFR 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501.

If an information disclosure statement does not comply with the requirements based on the time of filing of the IDS as discussed in subsection III.B above, including the requirements for fees and/or statement under 37 CFR 1.97(e), the IDS will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use form paragraph 6.49 which is reproduced below to inform applicant that the information has not been considered. Applicant may then file a new information disclosure statement or correct the deficiency in the previously filed IDS, but the date that the new IDS or correction is filed will be the date of the IDS for purposes of determining compliance with the



requirements based on the time of filing of the IDS (37 CFR 1.97).

The examiner should write "not considered" on an information disclosure statement where none of the information listed complies with the requirements, e.g., no copies of listed items submitted. If none of the information listed on a PTO-1449 or PTO/SB/08A and 08B form is considered, a diagonal line should also be drawn in pencil across the form and the form placed on the right side of the application file to instruct the printer not to list the information on the face of the patent if the application goes to issue. The paper containing the disclosure statement or list will be placed in the record in the application file. The examiner will inform applicant that the information has not been considered and the reasons why by using form paragraphs 6.49 through 6.49.09. If the improper citation appears as part of another paper, e.g., an amendment, which may be properly entered and considered, the portion of the paper which is proper for consideration will be considered.

If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner.

If information listed in the specification rather than in a separate paper, or if the other content requirements as discussed in subsection III.A above are not complied with, the information need not be considered by the examiner, in which case, the examiner should notify applicant in the next Office action that the information has not been considered.

#### (a) Form Paragraphs

##### ¶ 6.49 Information Disclosure Statement Not Considered

The information disclosure statement filed [1] fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because [2]. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any resubmission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all requirements for statements under 37 CFR 1.97(e). See MPEP § 609 subsection III, C(1).

#### Examiner Note:

See MPEP § 609 for situations where the use of this form paragraph would be appropriate.

##### ¶ 6.49.01 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Statement

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.02 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Fee

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.03 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Statement

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.05 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Fee

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(d) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.06 Information Disclosure Statement Not Considered, References Listed in Specification

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office, and MPEP § 609 subsection III A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

##### ¶ 6.49.07 Information Disclosure Statement Not Considered, No Copy of References

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; for each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion and all other information or that portion which caused it to be listed. It

has been placed in the application file, but the information referred to therein has not been considered.

**¶ 6.49.08 Information Disclosure Statement Not Considered, No List of References**

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, applications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

**¶ 6.49.09 Information Disclosure Statement Not Considered, No Explanation of Relevance of Non-English Language Information**

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(3)(i) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

**¶ 6.51 Time for Completing Information Disclosure Statement**

The information disclosure statement filed on [1] does not fully comply with the requirements of 37 CFR 1.98 because: [2]. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above-mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).** Failure to timely comply with this notice will result in the above-mentioned information disclosure statement being placed in the application file with the non-complying information **not** being considered. See 37 CFR 1.97(i).

**Examiner Note:**

Use this form paragraph if an IDS complies with the timing requirements of 37 CFR 1.97 but part of the content requirements of 37 CFR 1.98 has been inadvertently omitted.

This practice does not apply where there has been a deliberate omission of some necessary part of an Information Disclosure Statement or where the requirements based on the time of filing the statement, as set forth in 37 CFR 1.97, have not been complied with.

**C(2)Complying Information Disclosure Statements**

The information contained in information disclosure statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 will be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in

Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. Only where the relevancy of the information is actually discussed in the application file (either by the examiner or by the applicant) or where the information is relied upon to reject a claim in the application, will the information deemed to be "considered" (to the extent discussed) for the purposes of reexamination under the *Portola* guidelines. See MPEP § 2242 under the subsection "General Principles Governing Compliance With Portola Packaging."

Examiners must consider all citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 or PTO/SB/08A and 08B provides a clear record of which citations have been considered by the Office. The examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08A and 08B form. If the citations are submitted on a list other than on a form PTO-1449 or PTO/SB/08A and 08B, the examiner may write "all considered" and his or her initials to indicate that all citations have been considered. If any of the citations are considered, a copy of the submitted list, form PTO-1449, or PTO/SB/08A and 08B, as reviewed by the examiner, will be returned to the applicant with the next communication. Those citations not considered by the examiner will have a line drawn through the citation and any citations considered will have the examiner's initials adjacent thereto. The original copy of the list, form PTO-1449, or PTO/SB/08A and 08B will be entered into the application file. The copy returned to applicant will serve both as acknowledgement of receipt of the information disclosure statement and as an indication as to which references were considered by the examiner. Forms PTO-326 and PTOL-37 include a box to indicate the attachment of form PTO-1449 or PTO/SB/08A and 08B.

Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted (subsection III.A(3) above) and

insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English. The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent. See *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1377-78, 54 USPQ2d 1001, 1008 (Fed. Cir. 2000) (“[A]s MPEP Section 609C(2) reveals, the examiner’s understanding of a foreign reference is generally limited to that which he or she can glean from the applicant’s concise statement...Consequently, while the examiner’s initials require that we presume that he or she considered the [foreign] reference, this presumption extends only to the examiner’s consideration of the brief translated portion and the concise statement.”).

Since information is required to be submitted in a separate paper listing the citations rather than in the specification, there is no need to mark “All checked” or “Checked” in the margin of a specification containing citations.

If an item of information in an IDS fails to comply with requirements of 37 CFR 1.97 and 37 CFR 1.98, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner and will be appropriately initialed.

### **C (3) Documents Submitted As Part of Applicant’s Reply to Office Action**

Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a reply to an Office action.

At the same time, the document supplied and relied on by applicant as evidence need not be processed as an item of information that was cited in an information disclosure statement. The record should reflect whether the evidence was considered, but listing on a form (e.g., PTO-892, PTO-1449, or PTO/SB/08A and 08B) and appropriate marking of the form by the examiner is not required.

For example, if applicant submits and relies on three patents as evidence in reply to the first Office action and also lists those patents on a PTO-1449 or PTO/SB/08A and 08B along with two journal articles, but does not file a statement under 37 CFR 1.97(e) or the fee set forth in 37 CFR 1.17(p), it would be appropriate for the examiner to indicate that the teachings relied on by applicant in the three patents have been considered, but to line through the citation of all five documents on the PTO-1449 or PTO/SB/08A and 08B and to inform applicant that the information disclosure statement did not comply with 37 CFR 1.97(c).

### **D. Information Printed on Patent**

A citation listed on form PTO-1449 or PTO/SB/08A and 08B and considered by the examiner in accordance with this section will be printed on the patent. A citation listed in a separate paper, equivalent to but not on form PTO-1449 or PTO/SB/08A and 08B, and considered by the examiner in accordance with this section will be printed on the patent if the list is on a separate sheet which is clearly identified as an information disclosure statement and the list lends itself to easy capture of the necessary information by the Office printing contractor, i.e., each item of information is listed on a single line, the lines are at least double-spaced from each other, the information is uniform in format for each listed item, and the list includes a column for the examiner’s initials to

indicate that the information was considered. For patents printed after January 1, 2001, citations from information disclosure statements that are printed on the face of the patent will be distinguished from citations cited by the examiner on a form PTO-892. The citations cited by the examiner on a form PTO-892 will be marked with an asterisk. If an item of information is cited more than once in an IDS and on a form PTO-892, the citation of the item will be listed only once on the patent as a citation cited by the examiner.

If the applicant does not provide classification information for a citation, or if the examiner lines through incorrect classification data, the citation will be printed on the face of the patent without the classi-

fication information. If a U.S. patent application number is listed on a PTO-1449 or PTO/SB/08A and 08B form or its equivalent and the examiner considers the information and initials the form, the application number will be printed on the patent. Applicants may wish to list U.S. patent application numbers on other than a form PTO-1449 or PTO/SB/08A and 08B format to avoid the application numbers of pending applications being published on the patent. If a citation is not printed on the patent but has been considered by the examiner in accordance with this section, the patented file will reflect that fact as noted in subsection III.C(2) above.

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE



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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

**Burden Hour Statement:** This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO:** Assistant Commissioner for Patents, Washington, DC 20231.